

REMARKS/ARGUMENTS

The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe and claim the subject matter, which Applicants regard as the invention.

Claims 3–13, 22, 48, 54–55, 72–75, 78–82 and 84–90 remain in this application. Claims 1–2, 20, 23–32, 39–47, 49, 56–71, 76–77, and 83 have been canceled. Claims 14–19, 21, 33–38, 50–53, and 71 were withdrawn due to an earlier restriction requirement. Applicant reserves the right to present these withdrawn or canceled claims in a divisional application.

Claims 3–8, 48, 54–55, 78–82 and 84–90 were rejected under 35 U.S.C. §103(a) as being unpatentable over DeLapa *et al.* (U.S. 6,076,068) in view of Stumm (U.S. 5,768,528). Claims 9–13, 22, 54, and 72–83 were rejected as being unpatentable in further view of Walker (U.S. 6,240,396) and Sasmazel (U.S. 6,032,260) and Hughes. For the following reasons, the rejections are respectfully traversed.

Claims 84, as amended, recites (with emphasis added) “means for *electronically* sending an order for purchasing an electronic asset *including electronic data* for obtaining a service or product being offered for sale by a vendor” and “an exchange certificate issuance section for *electronically* transmitting an exchange certificate *including electronic data* to said first terminal or to a second terminal in response to said order, wherein said exchange certificate is used for verifying a user's right to receive said electronic asset” and wherein “said exchange certificate includes information about obtaining said electronic asset” and further wherein “said electronic asset is for obtaining the service or product from the vendor.” Claims 85–87 and 89 recited similar limitations. The cited references do not teach these elements of the claims.

The Examiner cites the coupon of DeLapa as teaching an exchange certificate. However, the coupon of the reference is nothing more than a custom *printed* coupon used in a manner that any discount coupon is used (see abstract). The coupon is printed on paper (see col. 7, lines 59–67), and is used at a point-of-sale to obtain a discount on a product purchase (see col. 5, lines 55–65).

However, there is no suggestion that this coupon includes any “electronic data” as recited in the claim. Furthermore, the coupon of DeLapa is a *paper* coupon, and there is no teaching that this coupon can be electronically transmitted.

Furthermore, the Examiner has not pointed to what element in DeLapa is supposed to teach the “electronic asset” of the invention. The coupon of the reference is used to obtain a discount for the purchase of a product. There is no suggestion that the coupon is “exchanged for” any *electronic asset*. DeLapa suggests obtaining the *product* directly when using the coupon. There is no exchange of any exchange certificate for an *electronic asset*, which is then used to obtain a service or product, as required by the claim. Thus, the reference does not teach the cited claim limitations.

Furthermore, claim 84 recites that the exchange certificate is used for “verifying a user's right to receive said electronic asset.” Claims 85–87 and 89 recited similar limitations. In contrast, the coupon of DeLapa does not provide any *right* to receive anything. It merely provides a discount for a product purchase. The product must still be purchased, and thus the coupon provides no “right” at all.

Stumm, Walker, Sasmazel and Hughes fail to overcome the shortcomings of DeLapa. Thus, for any of the above reasons, claims 84–87 and 89 are patentable over the reference. The remaining claims depend on one or more of claims 84–87 and 89, and thus are patentable over the references for the same reasons.

Furthermore, the Examiner has failed to provide the proper motivation for combining the references. The Examiner's arguments for adding references are nothing more than the generalized *benefits* of their teachings. It is not proper to merely rely on a general benefit of a teaching for adding that teaching to another reference. If such were considered proper motivation, then every reference would be self-motivating, and thus every invention based on new combinations of known elements would be obvious because such an argument can always be applied to any such new combination. Clearly, this is not legally proper.

Accordingly, the rejections for obviousness are not supported by the Office Action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32410.

Respectfully submitted,
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